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PTO/SB/21 (09-04)

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Number of Pages in This Submission

Application Number 09/728,471

Filing Date November 30, 2000

First Named Inventor Alan Young et al.

Art Unit 3627

Examiner Name Jaketic, B.

Attorney Docket Number CITI0207

## ENCLOSURES (check all that apply)

☒ Fee Transmittal Form☒ Fee Attached☐ Amendment / Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/  
Incomplete Application☐ Reply to Missing Parts  
under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☒ Petition☐ Petition to Convert to a  
Provisional Application☐ Power of Attorney, Revocation  
Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ Landscape Table on CD☐ After Allowance Communication to TC☐ Appeal Communication to Board  
of Appeals and Interferences☐ Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s)  
(please identify below):Statement of Facts in Support of Petition  
Under 37 CFR 1.47(a) When Inventor is  
Unavailable;

Exhibits A-I

Check for \$200

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm

Kilpatrick Stockton LLP

Signature

Printed Name

Todd W. Galinski

Date

December 10, 2004

Reg.  
No.

51,713

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

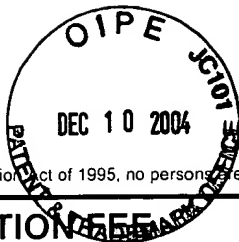
Signature

Typed or printed name

Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EXPRESS MAIL NO. EV4633 55805 US

PTO/SB/17p (11-04)

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**PETITION FEES**  
**Under 37 CFR 1.17(f), (g) & (h)**  
**TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	09/728,471
Filing Date	November 30, 2000
First Named Inventor	Alan Young et al.
Art Unit	3627
Examiner Name	Jaketic, B.
Attorney Docket Number	CITI0207

Enclosed is a petition filed under 37 CFR 1.47(a) that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 200 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

**Payment of Fees** (small entity amounts are NOT available for the petition fees)☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 50-1458:  
☐ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments  
Enclose a duplicative copy of this form for fee processing.☒ Check in the amount of \$ 200 is enclosed.☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

Signature

December 10, 2004

Date

Todd W. Galinski

Typed or printed name

51,713

Registration No., if applicable

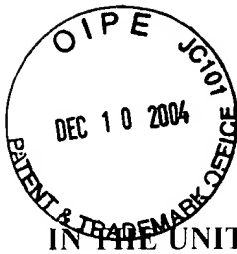
This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

12/14/2004 AWONDAF1 00000006 09728471

200.00 OP

01 FC:1463



Patents

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Young, Alan et al.  
Serial No. : 09/728,471  
For : **SYSTEM AND METHOD FOR PERFORMING AN  
ELECTRONIC TRANSACTION USING A  
TRANSACTION PROXY WITH AN ELECTRONIC  
WALLET**  
Filed : November 30, 2000  
Examiner : Jaketic, Bryan J.  
Art Unit : 3627

**PETITION UNDER 37 C.F.R. § 1.47(a)**  
**FILING WHEN INVENTOR IS UNAVAILABLE**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The undersigned requests consideration of this Petition on the basis that despite diligent efforts, an executed Declaration Under 37 C.F.R. §1.131 by all the inventors of the present invention is unavailable.

Of the three inventors named in the application, a copy of the executed Declaration Under 37 C.F.R. §1.131 is submitted herewith on behalf of Alan Young. Although several attempts were made to contact Philip G. Chapman and Robert M. Berardy, they were not found or reached after diligent effort. The attached Statement of Facts establishes that Mr. Chapman and Mr. Berardy could not be located and remain unavailable to sign the Declaration Under 37 C.F.R. §1.131.

Pursuant to the requirements of 37 C.F.R. §1.47(a), the last known address of the non-signing inventors is provided below:

Mr. Robert Berardy  
Citicorp Center, Cyber Bldg.  
2-3-14 Higashi-Shinagawa  
Shinagawa-ku  
Tokyo 1408639 JAPAN

Mr. Philip Chapman  
Citicorp Center, Cyber Bldg.  
2-3-14 Higashi-Shinagawa  
Shinagawa-ku  
Tokyo 1408639 JAPAN

In accordance with the fee requirement of 37 C.F.R. §1.17(g), a check in the amount of \$200.00 is provided herewith. Should any further fees be required for this consideration, please charge them to the Deposit Account 50-1458.

Respectfully submitted,



By: Todd W. Galinski  
Attorney for Applicants  
Reg. No. 51,713

Kilpatrick Stockton LLP  
607 14<sup>th</sup> Street NW, Suite 900  
Washington, DC 20005-2018  
(202) 508-5800



EXPRESS MAIL NO. EV46335805us  
Serial No. 09/728,471

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of : Young, Alan et al.  
Serial No. : 09/728,471  
For : **SYSTEM AND METHOD FOR PERFORMING AN  
ELECTRONIC TRANSACTION USING A  
TRANSACTION PROXY WITH AN ELECTRONIC  
WALLET**  
Filed : November 30, 2000  
Examiner : Jaketic, Bryan J.  
Art Unit : 3627

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION PURSUANT TO 37 C.F.R. § 1.131**

Dear Sir,

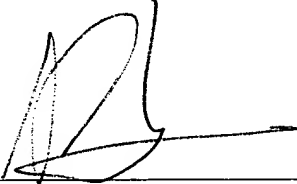
We, the undersigned, Alan Young, Philip G. Chapman, and Robert M. Berardy, each do hereby declare the following:

1. I am an original and joint inventor of the subject matter disclosed and claimed in the above-identified United States Patent Application.
2. I am over the age of 21 and are competent to make this declaration based on our personal knowledge.
3. During the conception and reduction to practice of the subject matter contained in the above-identified United States Patent Application I was employed by Citibank NA, the current assignee of the above-identified United States Patent Application.
4. This document is submitted as evidence that the subject matter recited in claims 1-69 of the above-identified United States Patent Application was conceived by my co-inventors and myself prior to May 9, 2000 and diligently reduced to practice thereafter.

5. Exhibit A is a copy of an email evidencing communications between one of the inventors, Philip Chapman, and a patent attorney, John Harrington, which took place on May 1, 2000. This email communication took place as part of the discussions relating to the preparation of a provisional application filed on May 18, 2000, and is further evidence of conception of the invention prior to May 9, 2000.

6. I hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: November 29<sup>th</sup>, 2004.

  
\_\_\_\_\_  
Alan Young

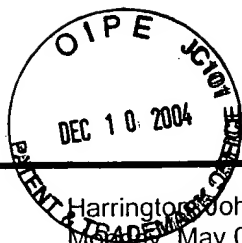
Dated: \_\_\_\_\_

\_\_\_\_\_  
Philip G. Chapman

Dated: \_\_\_\_\_

\_\_\_\_\_  
Robert M. Berardy

Harrington, John



**From:** Harrington, John  
**Sent:** Monday, May 01, 2000 5:54 PM  
**To:** 'philip.chapman@citicorp.com'  
**Cc:** Marcou, George; Holmes, Diana; 'david.schreiber@citicorp.com';  
'tamara.tishberg@citicorp.com'  
**Subject:** I-Mode Wallet (C0464.196869)

Philip, my apologies for omission of the re line in previous email.

Regards,  
John Harrington

-----Original Message-----

**From:** Harrington, John  
**Sent:** Monday, May 01, 2000 5:31 PM  
**To:** 'philip.chapman@citicorp.com'  
**Cc:** Marcou, George; Holmes, Diana; 'david.schreiber@citicorp.com'; 'tamara.tishberg@citicorp.com'  
**Subject:**



P07301\_.DOC

Dear Philip:

In follow up of our telephone conversation of April 27, 2000, attached is a draft of a second provisional patent application for the above-identified project based on the oral disclosure taken during the conversation.

As discussed, the attached draft includes the text of the provisional application already filed, plus the additional disclosure commencing at line 26 on page 8, as well as an additional attachment labeled "D" (not attached).

We note your comments regarding the inventorship list and will follow up shortly.

Please review the draft application for technical accuracy and provide us with any suggested changes, preferably in writing and suggesting specific word changes, if possible.

Best regards,

John M. Harrington  
Kilpatrick Stockton LLP

EXHIBIT A



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of : Young, Alan et al.  
Serial No. : 09/728,471  
For : **SYSTEM AND METHOD FOR PERFORMING AN  
ELECTRONIC TRANSACTION USING A  
TRANSACTION PROXY WITH AN ELECTRONIC  
WALLET**  
Filed : November 30, 2000  
Examiner : Jaketic, Bryan J.  
Art Unit : 3627

**STATEMENT OF FACTS IN SUPPORT OF PETITION  
UNDER 37 C.F.R. § 1.47(a) WHEN INVENTOR IS UNAVAILABLE**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following Statement of Facts is submitted in support of a petition under 37 CFR 1.47(a).

Multiple attempts to obtain a signed Declaration Under 37 C.F.R. §1.131 from Philip G. Chapman and Robert M. Berardy were made as shown by the attached documents.

Attachment A: March 9, 2001 FedEx receipt from original Declaration sent to Mr. Chapman evidencing his last known address.

Attachment B: March 9, 2001 FedEx receipt from original Declaration sent to Mr. Berardy evidencing his last known address.

Attachment C: October 28, 2004 email from Masako Wada evidencing the fact that Mr. Chapman and Mr. Berardy are no longer employed by the owner of the application, Citibank N.A., and their current whereabouts are unknown.



Attachment D: November 18, 2004 email to Mr. Chapman's last known email address including a copy of the Declaration Under 37 C.F.R. §1.131 for his signature.

Attachment E: November 18, 2004 email automatic reply from the System Administrator at the domain citicorp.com indicating the e-mail address for Mr. Chapman is no longer valid.

Attachment F: November 18, 2004 email to Mr. Berardy's last known email address including a copy of the Declaration Under 37 C.F.R. §1.131 for his signature.

Attachment G: November 18, 2004 email automatic reply from the System Administrator at the domain citicorp.com indicating the e-mail address for Mr. Berardy is no longer valid.

Attachment H: November 18, 2004 letter to Mr. Chapman enclosing the Declaration Under 37 C.F.R. §1.131 for his signature. A response was never received.

Attachment I: November 18, 2004 letter to Mr. Berardy enclosing the Declaration Under 37 C.F.R. §1.131 for his signature. A response was never received.

As evidenced by the above, several attempts were made to contact Mr. Chapman and Mr. Berardy by electronic mail, standard mail, and telephone. There has been no response or success from either Mr. Chapman or Mr. Berardy to any of the attempts to locate them.

Date: 12/10/04

Todd W. Galinski  
Todd W. Galinski (Reg. No. 51,713)

EXPRESS MAIL NO. EV463855805US

Orig. ID: JPNA  
 From: George T. Marcou (202) 508-5800  
 KILPATRICK STOCKTON LLP  
 700 13TH STREET, NW, SUITE 800

WASHINGTON  
 DC 20005 (US)

To: Philip Chapman 01181356425752  
 Citicorp Center, Cyber Bldg.  
 2-3-14 Higashi-Shinagawa  
 Shinagawa-ku  
 Tokyo 1408639 JAPAN (JP)

Description  
 Documents

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NSR Section 30.55(h) FTSR

IRS/EIN:  
 SHIP DATE: 09MAR01  
 WEIGHT: 1.0 LBS

Country Mfg.

CUSTOM VALUE: 1.00 USD  
 CARRIAGE VALUE: 1.00 USD

BILL T/C: S 020050101  
 BILL D/T: S 020050101

Ref: 196869  
 Signature: George T. Marcou

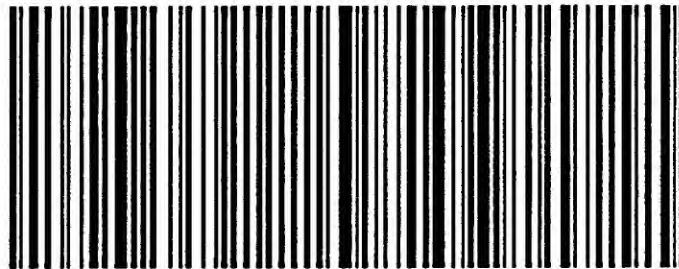
TRK # 7909 1788 9004 FORM 0430

1408639 JP

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EXPRESS MAIL NO. EV463355805US

Orig. ID: JPNA  
From: George T. Marcou (202) 508-5800  
KILPATRICK STOCKTON LLP  
700 13TH STREET, NW, SUITE 800

WASHINGTON  
DC 20005 (US)

To: Robert Berardy 01181356425752  
Citicorp Center, Cyber Bldg.  
2-3-14 Higashi-Shinagawa  
Shinagawa-ku  
Tokyo 1408639 JAPAN (JP)

Description  
Documents

SHIPPER'S FEDEX ACCOUNT #



NSR Section 30.55(h) FTSR

**FedEx.**

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SHIP DATE: 09MAR01  
WEIGHT: 1.0 LBS

Country Mfg.

CUSTOM VALUE: 1.00 USD  
CARRIAGE VALUE: 1.00 USD

BILL T/C: S 020050101  
BILL D/T: S 020050101

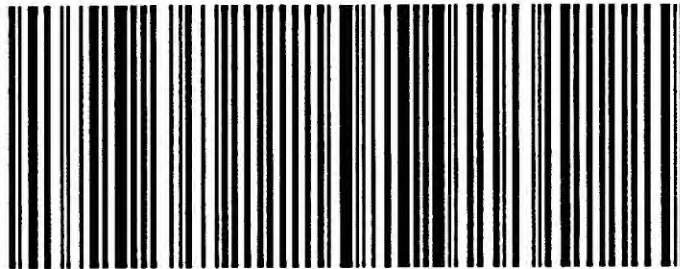
Ref: 196869  
Signature: George T. Marcou

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2. Fold the printed page along the horizontal line.
3. Place 2 original labels (Consignee, Manifest/Billing) in the international shipping label pouch and affix it to your shipment so that the barcode portion of the label can be read and scanned.
4. To print a receipt of your shipment, please click on "Shipping History."

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**Galinski, Todd**

---

**From:** Wada, Masako [wadam@citigroup.com]  
**Sent:** Thursday, October 28, 2004 1:30 PM  
**To:** Turpie, Linda  
**Cc:** Hogans, Sonya Y.; Harrington, John; Galinski, Todd  
**Subject:** RE: Citibank/I-mode Wallet (C0464/196869) CITI 0207

**Importance:** High

Hi, Linda:

Apologies for the delay in responding to your e-mail. Alan Young's resident address is as attached and his e-mail address is younga@citigroup.com. His office number is 212/559-2314.

Berardy and Chapman left the bank. They do not exist on the Global Directory any longer.

Let me know if you would need further information.

Thank you and regards,

Masako Wada  
Assistant to David Schreiber  
212.559.1833  
wadam@citigroup.com

-----Original Message-----

**From:** Young, Alan  
**Sent:** Thursday, October 28, 2004 12:16 PM  
**To:** Wada, Masako  
**Cc:** Cofresi, Ann  
**Subject:** RE: COULD YOU DO US A FAVOR ?! === Citibank/I-mode Wallet (C0464/196869) CITI 0207

Alan Young  
63 Garibaldi Lane  
New Canaan  
CT 06840

I think that Philip Chapman left the bank. I have no idea what his current address is.  
Alan

-----Original Message-----

**From:** Turpie, Linda [mailto:LTurpie@KilpatrickStockton.com]  
**Sent:** Thursday, October 28, 2004 1:19 PM  
**To:** wadam@citigroup.com  
**Cc:** hoganss@citigroup.com; Harrington, John; Galinski, Todd  
**Subject:** RE: Citibank/I-mode Wallet (C0464/196869) CITI 0207

Masako,

Just wondering if you have had a chance to look into this. It's rather urgent.

Thanks.

Linda

-----Original Message-----

**From:** Turpie, Linda

Sent: Thursday, October 28, 2004 9:44 AM  
To: 'wadam@citigroup.com'  
Cc: 'hoganss@citigroup.com'; Harrington, John; Galinski, Todd  
Subject: FW: Citibank/I-mode Wallet (C0464/196869) CITI 0207  
Importance: High

Good morning Masako,

Sonya asked if you could look these up in the system since she cannot access it from CA. We also need current home addresses and email addresses to obtain signatures. Many thanks.

Linda

-----Original Message-----

From: Turpie, Linda  
Sent: Thursday, October 28, 2004 9:27 AM  
To: 'hoganss@citigroup.com'  
Cc: Harrington, John; Galinski, Todd  
Subject: FW: Citibank/I-mode Wallet (C0464/196869) CITI 0207  
Importance: High

Sonya, can you please let us know if the following inventors are still with Citibank?

Alan Young (Citibank in NY in 2001)  
Philip Chapman (Citibank in Tokyo in 2001)  
Robert Berardy (also Citibank in Tokyo in 2001)

Many thanks.

Linda

-----Original Message-----

From: Harrington, John  
Sent: Wednesday, October 27, 2004 4:45 PM  
To: Turpie, Linda  
Cc: Galinski, Todd  
Subject: FW: Citibank/I-mode Wallet (C0464/196869) CITI 0207

Linda,

In follow-up of my phone message of 10/27/04, in furtherance of a possible RCE in the above matter, it would be very helpful to us to obtain the inventors' signatures on a declaration to swear behind a reference. The named inventors are Alan Young (Citibank in NY in 2001), Philip Chapman (Citibank in Tokyo in 2001), and Robert Berardy (also Citibank in Tokyo in 2001). Can you please follow up with Sonya to see if they are still available and if so, what their current contact information is. Many thanks.

John H.

**Galinski, Todd**

---

**From:** Galinski, Todd  
**Sent:** Thursday, November 18, 2004 2:24 PM  
**To:** 'philip.chapman@citicorp.com'  
**Subject:** URGENT: Signature Needed for Patent Application



CITI0207 I-Mode  
Wallet 1.131 D...

Dear Mr. Chapman:

I am an attorney responsible for prosecution of the above-referenced patent application for which you are a co-inventor. In conjunction with this application, we need to establish a date of invention prior to May 9, 2000 in order to circumvent a rejection by the patent office. A provisional application leading to the above-referenced utility application was filed on May 18, 2000 and contains the information necessary to overcome the rejection. The attached Declaration states that you conceived the invention contained in that provisional application prior to May 9, 2000, and is supported by evidence of a conversation between one of the inventors (yourself) and a patent attorney (Mr. Harrington).

We would appreciate your signing and dating this Declaration where indicated and returning it to me using the enclosed return label. We are running against a deadline and would appreciate the return document as soon as possible.

Thank you for your assistance with this matter. If you have any questions, please do not hesitate to contact me.

Todd W. Galinski  
Kilpatrick Stockton LLP  
1001 West Fourth Street  
Winston-Salem, NC 27101-2400  
t 336 607 7448  
f 336 734 2654

**Confidentiality Notice:**

This communication constitutes an electronic communication within the meaning of the Electronic Communications Privacy Act, 18 U.S.C. Section 2510, and its disclosure is strictly limited to the recipient intended by the sender of this message. This transmission, and any attachments, may contain confidential attorney-client privileged information and attorney work product. If you are not the intended recipient, any disclosure, copying, distribution or use of any of the information contained in or attached to this transmission is STRICTLY PROHIBITED. Please contact us immediately by return e-mail or at 336 607 7300, and destroy the original transmission and its attachments without reading or saving in any manner.

**Galinski, Todd**

---

**From:** System Administrator  
**To:** philip.chapman@citicorp.com  
**Sent:** Thursday, November 18, 2004 2:24 PM  
**Subject:** Undeliverable:Returned mail: see transcript for details

Your message did not reach some or all of the intended recipients.

Subject: URGENT: Signature Needed for Patent Application  
Sent: 11/18/2004 2:24 PM

The following recipient(s) could not be reached:

philip.chapman@citicorp.com on 11/18/2004 2:23 PM

The e-mail account does not exist at the organization this message was sent to. Check the e-mail address, or contact the recipient directly to find out the correct address.

<imbaspam-nj04.iplex.ssmb.com #5.1.1 SMTP; 550 5.1.1 <philip.chapman@citicorp.com>... User unknown>

**Galinski, Todd**

---

**From:** Galinski, Todd  
**Sent:** Thursday, November 18, 2004 2:24 PM  
**To:** 'robert.berardy@citicorp.com'  
**Subject:** URGENT: Signature Needed for Patent Application



CITI0207 I-Mode  
Wallet 1.131 D...

Dear Mr. Berardy:

I am an attorney responsible for prosecution of the above-referenced patent application for which you are a co-inventor. In conjunction with this application, we need to establish a date of invention prior to May 9, 2000 in order to circumvent a rejection by the patent office. A provisional application leading to the above-referenced utility application was filed on May 18, 2000 and contains the information necessary to overcome the rejection. The attached Declaration states that you conceived the invention contained in that provisional application prior to May 9, 2000, and is supported by evidence of a conversation between one of the inventors (Mr. Chapman) and a patent attorney (Mr. Harrington).

We would appreciate your signing and dating this Declaration where indicated and returning it to me by facsimile at the number below with follow-up by standard delivery. We are running against a deadline and would appreciate the return document as soon as possible.

Thank you for your assistance with this matter. If you have any questions, please do not hesitate to contact me.

Todd W. Galinski  
Kilpatrick Stockton LLP  
1001 West Fourth Street  
Winston-Salem, NC 27101-2400  
t 336 607 7448  
f 336 734 2654

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 **KILPATRICK  
STOCKTON LLP**  
Attorneys at Law

1001 West Fourth St.  
Winston-Salem NC 27101-2400  
t 336 607 7300 f 336 607 7500  
www.KilpatrickStockton.com

Todd W. Galinski  
direct dial 336 607 7448  
direct fax 336 734 2654  
TGalinski@KilpatrickStockton.com

November 18, 2004

Mr. Philip Chapman  
Citicorp Center, Cyber Bldg.  
2-3-14 Higashi-Shinagawa  
Shinagawa-ku  
Tokyo 1408639 JAPAN

**Re: US Patent Application Serial No. 09/728,471**  
**For: System and Method for Performing An Electronic**  
**Transaction Using A Transaction Proxy With**  
**An Electronic Wallet**  
**Filed: November 30, 2000**  
**Our Ref: C0464/196869 (CITI0207)**

Dear Mr. Chapman:

I am an attorney responsible for prosecution of the above-referenced patent application for which you are a co-inventor. In conjunction with this application, we need to establish a date of invention prior to May 9, 2000 in order to circumvent a rejection by the Patent Office. A provisional application leading to the above-referenced utility application was filed on May 18, 2000 and contains the information necessary to overcome the rejection. The attached Declaration states that you conceived the invention contained in that provisional application prior to May 9, 2000, and is supported by evidence of a conversation between one of the inventors (Mr. Chapman) and a patent attorney (Mr. Harrington).

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Mr. Philip Chapman  
November 18, 2004  
Page 2

Thank you for your assistance with this matter. If you have any questions, please do not hesitate to contact me.

Very truly yours,

A handwritten signature in black ink, appearing to read "Todd W. Galinski", with a stylized flourish at the end.

Todd W. Galinski

TWG/caj  
Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Young, Alan et al.  
Serial No. : 09/728,471  
For : **SYSTEM AND METHOD FOR PERFORMING AN  
ELECTRONIC TRANSACTION USING A  
TRANSACTION PROXY WITH AN ELECTRONIC  
WALLET**  
Filed : November 30, 2000  
Examiner : Jaketic, Bryan J.  
Art Unit : 3627

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

DECLARATION PURSUANT TO 37 C.F.R. § 1.131

Dear Sir,

We, the undersigned, Alan Young, Philip G. Chapman, and Robert M. Berardy, each do hereby declare the following:

1. I am an original and joint inventor of the subject matter disclosed and claimed in the above-identified United States Patent Application.
2. I am over the age of 21 and are competent to make this declaration based on our personal knowledge.
3. During the conception and reduction to practice of the subject matter contained in the above-identified United States Patent Application I was employed by Citibank NA, the current assignee of the above-identified United States Patent Application.
4. This document is submitted as evidence that the subject matter recited in claims 1-69 of the above-identified United States Patent Application was conceived by my co-inventors and myself prior to May 9, 2000 and diligently reduced to practice thereafter.

5. Exhibit A is a copy of an email evidencing communications between one of the inventors, Philip Chapman, and a patent attorney, John Harrington, which took place on May 1, 2000. This email communication took place as part of the discussions relating to the preparation of a provisional application filed on May 18, 2000, and is further evidence of conception of the invention prior to May 9, 2000.

6. I hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: \_\_\_\_\_

\_\_\_\_\_  
Alan Young

Dated: \_\_\_\_\_

\_\_\_\_\_  
Philip G. Chapman

Dated: \_\_\_\_\_

\_\_\_\_\_  
Robert M. Berardy

Harrington, John

---

**From:** Harrington, John  
**Sent:** Monday, May 01, 2000 5:54 PM  
**To:** 'philip.chapman@citicorp.com'  
**Cc:** Marcou, George; Holmes, Diana; 'david.schreiber@citicorp.com';  
'tamara.tishberg@citicorp.com'  
**Subject:** I-Mode Wallet (C0464.196869)

Philip, my apologies for omission of the re line in previous email.

Regards,  
John Harrington

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**Subject:**



P07301\_.DOC

Dear Philip:

In follow up of our telephone conversation of April 27, 2000, attached is a draft of a second provisional patent application for the above-identified project based on the oral disclosure taken during the conversation.

As discussed, the attached draft includes the text of the provisional application already filed, plus the additional disclosure commencing at line 26 on page 8, as well as an additional attachment labeled "D" (not attached).

We note your comments regarding the inventorship list and will follow up shortly.

Please review the draft application for technical accuracy and provide us with any suggested changes, preferably in writing and suggesting specific word changes, if possible.

Best regards,

John M. Harrington  
Kilpatrick Stockton LLP

EXHIBIT A



1001 West Fourth St.  
Winston-Salem NC 27101-2400  
t 336 607 7300 f 336 607 7500  
www.KilpatrickStockton.com

November 18, 2004

Todd W. Galinski  
direct dial 336 607 7448  
direct fax 336 734 2654  
TGalinski@KilpatrickStockton.com

Mr. Robert Berardy  
Citicorp Center, Cyber Bldg.  
2-3-14 Higashi-Shinagawa  
Shinagawa-ku  
Tokyo 1408639 JAPAN

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Mr. Robert Berardy  
November 18, 2004  
Page 2

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Dated: \_\_\_\_\_

\_\_\_\_\_  
Alan Young

Dated: \_\_\_\_\_

\_\_\_\_\_  
Philip G. Chapman

Dated: \_\_\_\_\_

\_\_\_\_\_  
Robert M. Berardy

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Best regards,

John M. Harrington  
Kilpatrick Stockton LLP

EXHIBIT A



## EXPRESS MAIL CERTIFICATE

"Express Mail" mailing label number : EV 463355805 US

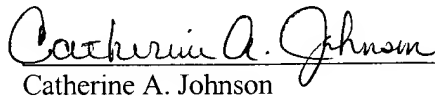
Date of Deposit : December 10, 2004

Type of Document(s) : Transmittal Form;  
Petition Fee Transmittal (*In Duplicate*);  
Petition Under 37 CFR 1.47(a) Filing When  
Inventor is Unavailable;  
Copy of Declaration Under 37 CFR 1.131;  
Statement of Facts in Support of Petition Under  
37 CFR 1.47(a);  
Exhibits A-I;  
Check for \$200.00; and  
Return Postcard

Serial No. : 09/728,471

Filing Date : November 30, 2000

I hereby certify that the documents identified above are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and are addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Catherine A. Johnson